

Remarks

Applicant appreciates the allowance of claims 1-17 in the present application.

Applicant hereby adds new claim 37. Accordingly, claims 1-37 are pending in the present application.

Claims 18-36 stand rejected under 35 USC 103(a) for obviousness over U.S. Patent No. 5,903,383 to Bernstein in view of U.S. Patent No. 6,608,620 to Suzuki et al.

Applicant respectfully traverses the rejections and urges allowance of the present application.

Referring to the rejection of claim 18, Applicant respectfully submits that the Office has failed to establish a proper *prima facie* rejection and claim 18 is allowable for at least this reason.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See, e.g., MPEP §2143 (8th ed., rev. 2).

Initially, there is no motivation to combine the reference teachings and the rejection of claim 18 is improper for at least this reason. On page 3 of the Action, it is stated that the combination is appropriate to allow the user to project the image in a conventional image pattern (i.e., RGB parallel stripes) to allow the user to view the image on a conventional display. Applicant respectfully submits that the alleged motivation is deficient to support a proper 103 rejection.

There is no evidence of record that Bernstein is deficient for its intended operation of generating images by reflecting light using micromirror devices. There is no evidence of record that any improvement would result by combining the disparate teachings of Suzuki with the teachings of Bernstein as to motivate one to make the combination. Applicant submits there is no evidence of record that Bernstein can not project images to allow a user to view an image. Applicant respectfully submits the lack of evidence of motivation illustrates the

inappropriateness of the 103 rejection.

The Federal Circuit discussed proper motivation *In re Lee*, 61 USPQ 2d 1430 (Fed. Cir. 2002). The motivation identified in the Office Action is akin to the conclusory statements set forth in *In re Lee* which were found to fail to provide the requisite motivation to support an obviousness rejection. The Court in *In re Lee* stated the factual inquiry whether to combine references must be thorough and searching. It must be based on objective evidence of record. The Court in *In re Fritch*, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992) stated motivation is provided only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. The *Lee* Court stated that the Examiner's conclusory statements in the *Lee* case do not adequately address the issue of motivation to combine. The Court additionally stated that the factual question of motivation is material to patentability and can not be resolved on subjective belief and unknown authority. The Court also stated that deficiencies of cited references cannot be remedied by general conclusions about what is basic knowledge or common sense. The Court further stated that the determination of patentability must be based on evidence.

In the instant case, the record is entirely devoid of any evidence to support motivation to combine the teachings apart from the bald conclusory statements of the Examiner which are insufficient for proper motivation as set forth by the Federal Circuit. The Office cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims but must set forth objective rationale on which it relied.

Bernstein and Suzuki are directed towards disparate technologies. Bernstein is directed towards micromirror devices which are selectively controlled to reflect light to form images wherein Suzuki is directed towards liquid crystal displays (LCD), field emission displays (LED), electroluminescent displays (ED), and light emitting displays (LED) as set forth in col. 1 of Suzuki. Applicant has electronically searched Suzuki and failed to *uncover any teachings regarding mirrors or reflection of light*. Apart from unsupported cursory statements of the Office not supported by any objective evidence of record, there is no evidence that Bernstein is deficient with respect to image generation operations, that any improvements would result

from the combination or that an operable device would result from the combination of the prior art teachings as presented by the Office to motivate one to combine the prior art teachings in the first instance. As set forth by the applicable authority, without proper motivation, the Office has failed to establish a proper 103 rejection and claim 18 is allowable for at least this reason.

In view of the disparate technologies of Bernstein and Suzuki, there is no evidence that an operable device would likely result or there is any likelihood or reasonable expectation of success of combining the references as proposed by the Office. The Office has failed to establish a proper 103 rejection for this additional reason.

In addition, even if the reference teachings are combined, the combination fails to teach or suggest limitations of Applicant's claim 18 reflective micro-mirror light valve. Initially, Applicant respectfully traverse the allegation on page 3 of the Action that it is inherent for a micromirror to include pixels which include 3 subpixels. The Office must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied prior art. *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). No such determination has been provided and the claimed three subpixels do not necessarily flow from the prior art teachings as is required for proper reliance upon inherency.

It is stated on page 3 of the Action that Bernstein fails to disclose or suggest the claimed pixels end to end to form parallel stripes corresponding to the size and configuration of a color stripe illumination pattern. It is thereafter alleged that Suzuki discloses a display apparatus which utilizes a parallel stripe pattern which corresponds to a size and configuration of a color stripe illumination pattern. Applicant has electronically searched and failed to uncover any teachings in Suzuki regarding a pattern or a parallel stripe pattern. The limitations of claim 18 including the *parallel stripes corresponding to the size and configuration of a color stripe illumination pattern* are not disclosed nor suggested by the combined prior art teachings relied upon by the Office and claim 18 is allowable for at least this additional reason.

The claims which depend from independent claim 18 are in condition for allowance for the reasons discussed above with respect to the independent claim as

well as for their own respective features which are neither shown nor suggested by the cited art.

For example, referring to claim 22, the Office has failed to identify any specific prior art teachings which allegedly disclose the limitations of claim 22 and Applicant has been unable to locate any teachings in Bernstein or Suzuki regarding individual *sub-pixels being configured to reflect only one color of the color stripe illumination pattern*. Claim 22 is allowable for at least this reason.

Referring to claim 23, the Office has failed to identify any specific prior art teachings which allegedly disclose the limitations of claim 23 and Applicant has been unable to locate any teachings in Bernstein or Suzuki regarding simultaneous reflection of light of the color stripe illumination pattern having at least two different colors. Claim 23 is allowable for at least this reason.

Referring to claim 28, the Office has failed to identify any specific prior art teachings which allegedly disclose the claimed color stripe illumination pattern lying within an illumination stripe focal plane upstream of the light valve. Claim 28 is allowable for at least this reason.

Referring to claim 31, the Office has failed to identify any specific prior art teachings which allegedly disclose the claimed sub-pixels individually reflect light of the same color during all operations of the reflective light valve wherein light is reflected to create an image. Claim 31 is allowable for at least this reason.

Referring to claim 32, the Office has failed to identify any specific prior art teachings which allegedly disclose the claimed color stripe illumination pattern being generated *prior to being reflected* by the sub-pixels. Claim 32 is allowable for at least this reason.

Applicant respectfully traverses the taking of Official Notice as set forth on page 4 of the Action. MPEP 2144.03A (8th ed. rev. 2) provides that *official notice unsupported by documentary evidence should only be taken by the examiner when the facts asserted to be well known or to be common knowledge in the art are capable of **instant and unquestionable demonstration as being well known***. It is **not appropriate** for the Office to take office notice of facts without a reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. Applicant respectfully requests that the Office cite evidence in support of the rejection if claims 32 and 35-36 are not allowed.

Referring to claim 34, the Office has failed to identify any specific prior art teachings which allegedly disclose the claimed full-color screen pixels individually comprising a substantially square shape and sub-pixels comprise substantially rectangular shapes. Claim 34 is allowable for at least this reason.

Applicant has identified herein numerous claimed limitations which are not disclosed nor suggested by the teachings of the prior art identified by the Office. In the event that a rejection of the claims is maintained with respect to the prior art, or a new rejection made, Applicant respectfully requests identification *in a non-final action* of elements which allegedly correspond to limitations of the claims in accordance with 37 C.F.R. §1.104(c)(2). In particular, 37 C.F.R. §1.104(c)(2) provides that *the pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified*. Further, 37 C.F.R. §1.104(c)(2) states that the Examiner must cite the best references at their command. *When a reference is complex or shows or describes inventions other than that claimed by Applicant, the particular teachings relied upon must be designated as nearly as practicable*. Applicant respectfully requests clarification of the rejections with respect to specific references and specific reference teachings therein pursuant to 37 C.F.R. §1.104(c)(2) in a *non-final Action* if any claims are not found to be allowable.

Support for new claim 37 may be found at least at Fig. 1 and the associated specification teachings of the originally-filed application.

Applicant respectfully requests allowance of all pending claims.

The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Time Zone).

Respectfully submitted,
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By: _____

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